

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS M. BEGGINS

Appeal No. 1999-2091
Application No. 08/792,765¹

ON BRIEF

Before NASE, CRAWFORD, and, BAHR Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 3 and 5 to 23. Claim 4 has been objected to as depending from a non-allowed claim. No claim has been canceled.

We REVERSE and enter a new rejection pursuant to 37 CFR § 1.196(b).

¹ Application for patent filed February 4, 1997.

BACKGROUND

The appellant's invention relates to apparatus for maintaining cold containerized liquids in a cold state and, more particularly, to a two-part telescopic lightweight portable bottle cooler apparatus (specification, p. 1). Claims 1, 3 and 18 are representative of the subject matter on appeal and a copy of those claims appears in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Buddrus	3,120,319	Feb. 4, 1964
Cooper	4,456,134	June 26, 1984
Augur	4,811,858	Mar. 14, 1989

Claims 1 to 3 and 5 to 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cooper in view of Augur.

Claims 1 to 3 and 5 to 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cooper in view of Augur and Buddrus.

Claims 1, 6, 11 and 20 to 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cooper in view of Augur and Buddrus.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 19, mailed December 8, 1998) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 18, filed September 17, 1998) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The appellant argues (brief, pp. 10, 13 and 14) that the limitation that the first and second thread means provide a "quick plunge insertion" as recited in independent claims 1, 6, 11 and 18 is not taught by Cooper. The examiner has determined (answer, pp. 8-9) that this limitation is met by Cooper's threads 18, 26 since those threads provide "quick plunge insertion" to the degree set forth in the claims and to the degree supported by the specification. The examiner also stated that "the

specification, claims and drawings do not provide any limits for determining what may or may not be considered 'quick plunge insertion' threads." Thus, this appeal requires us to fully understand² the scope of the terminology "quick plunge insertion" as used in claims 1, 6, 11 and 18.

The term "quick plunge insertion" as used in claims 1, 6, 11 and 18 is a term of degree. When a word of degree is used, it is necessary to determine whether the specification provides some standard for measuring that degree. See Seattle Box Company, Inc. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 573-74 (Fed. Cir. 1984).

Admittedly, the fact that some claim language, such as the term of degree mentioned supra, may not be precise, does not automatically render the claim indefinite under the second paragraph of § 112. Seattle Box, supra. Nevertheless, the need to cover what might constitute insignificant variations of an invention does not amount to a license to resort to the unbridled

² Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988).

use of such terms without appropriate constraints to guard against the potential use of such terms as the proverbial nose of wax.³

In Seattle Box, the court set forth the following requirements for terms of degree:

[w]hen a word of degree is used the district court must determine whether the patent's specification provides some standard for measuring that degree. The trial court must decide, that is, whether one of ordinary skill in the art would understand what is claimed when the claim is read in light of the specification.

In Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir. 1985), the court added:

[i]f the claims, read in light of the specifications [sic], reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more.

³ See White v. Dunbar, 119 U.S. 47, 51-52 (1886) and Townsend Engineering Co. v. HiTec Co. Ltd., 829 F.2d 1086, 1089-91, 4 USPQ2d 1136, 1139-40 (Fed. Cir. 1987).

Indeed, the fundamental purpose of a patent claim is to define the scope of protection⁴ and hence what the claim precludes others from doing. All things considered, because a patentee has the right to exclude others from making, using and selling the invention covered by a United States letters patent, the public must be apprised of what the patent covers, so that those who approach the area circumscribed by the claims of a patent may more readily and accurately determine the boundaries of protection in evaluating the possibility of infringement and dominance. See In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

In the present case, we have reviewed the appellant's disclosure to help us determine the meaning of "quick plunge insertion." That review has revealed that the appellant's specification states: (1) at page 2, lines 12-26, that the threads are "relatively steeply arched," (2) at page 2, lines 27-31, that the quick plunge feature "preferably provides complete insertion with a minimum of turning of the upper enclosure," and (3) at page 4, lines 24-31, that "the 'steepness' of the threads 33, 35 are preferably selected such that minimal turning of the

⁴ See In re Vamco Machine & Tool, Inc., 752 F.2d 1564, 224 USPQ 617 (Fed. Cir. 1985).

upper enclosure 13 is required to secure the upper enclosure 13 with the lower enclosure 15, thus providing a deep plunge, quick insertion feature." Additionally, the appellant's Figures 1 and 3-5 show threads 33, 35 on enclosures 13, 15.

However, these portions of the disclosure do not provide explicit guidelines defining the terminology "quick plunge insertion." Furthermore, there are no guidelines that would be implicit to one skilled in the art defining the term "quick plunge insertion" that would enable one skilled in the art to ascertain what is meant by "quick plunge insertion." For example, one cannot ascertain if the threads 18, 26 of Cooper provide "quick plunge insertion" of upper shell 22 into lower cup 12. Absent such guidelines, we are of the opinion that a skilled person would not be able to determine the metes and bounds of the claimed invention with the precision required by the second paragraph of 35 U.S.C. § 112. See In re Hammack, supra.

Since the appellant's disclosure fails to set forth an adequate definition as to what is meant by the terminology "quick plunge insertion" as used in independent claims 1, 6, 11 and 18, the appellant has failed to particularly point out and distinctly

claim the invention as required by the second paragraph of 35 U.S.C. § 112.

NEW GROUND OF REJECTION

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claims 1 to 23 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention, for the reasons explained above.

As set forth previously, our review of the specification leads us to conclude that one of ordinary skill in the art would not be able to understand the metes and bounds of the terminology "quick plunge insertion" in independent claims 1, 6, 11 and 18.

THE OBVIOUSNESS REJECTIONS

We emphasize again here that the pending claims contain unclear language which renders the subject matter thereof indefinite for the reasons stated supra as part of our new rejection under 35 U.S.C. § 112, second paragraph. We find that it is not possible to apply the prior art to claims 1 to 3 and 5

to 23 in deciding the question of obviousness under 35 U.S.C. § 103 without resorting to speculation and conjecture as to the meaning of the questioned limitation in independent claims 1, 6, 11 and 18. This being the case, we are therefore constrained to reverse the examiner's rejection of claims 1 to 3 and 5 to 23 under 35 U.S.C. § 103 in light of the holding in In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). This reversal of the examiner's rejections is based only on the procedural ground relating to the indefiniteness of these claims and therefore is not a reversal based on the merits of the rejections.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 3 and 5 to 23 under 35 U.S.C. § 103 is reversed.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of

the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b)

JEFFREY V. NASE)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MURRIEL E. CRAWFORD)	APPEALS
Administrative Patent Judge)	AND
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JENNIFER D. BAHR)	
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